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Filed : July 28, 2003

### AMENDMENTS TO THE DRAWINGS

New FIG. 3A-1 is attached hereto in the Appendix. New FIG. 3A-1 shows a first lens support being configured to allow the first lens to pivot relative to the frame between at least first and second positions, wherein the lens provides a first magnitude of light attenuation when the first lens is in a first position and less light attenuation when the first lens is pivoted to the second position.

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### REMARKS

Applicants thank the Examiner for his careful and thoughtful examination of the present Application. By way of summary, Claims 14-33 were and remain pending. In response to the Office Action mailed May 22, 2006, Applicants respectfully request the Examiner to reconsider the above-captioned Application in view of the following comments.

#### The Drawings Comply With MPEP § 608.02(d)

The Office Action objected to the drawings for failing to show "the first lens to pivot relative to the frame between at least first and second positions, wherein the lens provides a first magnitude of light attenuation when the first lens is in a first position and less light attenuation when the first lens is pivoted to the second position." Office Action of May 22, 2006, page 2. New FIG. 3A-1 has been added in the attached Appendix to show the element described above.

The drawing amendments are supported throughout the originally filed specification. For example, at paragraph no. [0055] the originally filed specification states:

Preferably, the lenses 44, 46 are configured to provide variable light attenuation. For example, each of the lenses 44, 46 can comprise a pair of stacked polarized lenses, with one of the pair being rotatable relative to the other. For example, each lens of the stacked pairs can comprise an iodine stained polarizing element. By rotating one lens relative to the other, the alignment of the polar directions of the lenses changes, thereby changing the amount of light that can pass through the pair. U.S. Patent No. 2,237,567 discloses iodine stained polarizers and is hereby expressly incorporated herein by reference. Additionally, rotatable lens designs are disclosed in U.S. Patent No. 4,149,780, which is hereby expressly incorporated herein by reference.

Accordingly, Applicants respectfully submit that no new matter is introduced by the proposed drawing changes and therefore respectfully request the Examiner to withdraw the objection to the drawings.

FIG. 3A-1 was provided in the Response to Office Action of December 14, 2005, but was not entered. The Office Action indicates that new FIG. 3A-1 fails to disclose the claim language provided above. Applicants respectfully request consideration in view of the following.

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Section 608.02(d) of the M.P.E.P. and 37 C.F.R. § 1.83(a) provide (emphasis added):

The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings.

Applicants respectfully submit that the features described above are not essential for a proper understanding of the invention, and should be acceptable in their representation of FIG. 3A-1 as illustrated in the form provided (i.e., labeled rectangular boxes). In particular, Applicants submit that a first lens to pivot relative to the frame between at least first and second positions, wherein the lens provides a first magnitude of light attenuation when the first lens is in a first position and less light attenuation when the first lens is pivoted to the second position are features whose detailed illustration is not essential for a proper understanding of the invention. Therefore, Applicants respectfully request entry of FIG. 3A-1 and withdrawal of the drawing objection.

**The Applied Combination of Swab, et al./Bylander Does Not Make Obvious Claims 14-21**

Claims 14-21 stand rejected under 35 U.S.C. § 103(a) as being obvious over Swab, et al. in view of Bylander. Applicants respectfully traverse the present rejection.

Swab, et al. teach eyewear with a transceiver for forming ad hoc networks. However, as admitted by the Office Action, nothing in Swab, et al. teaches or suggests any devices for changing the light attenuation provided by the lenses thereof.

Bylander teaches a variable light attenuation system for eyewear that uses electronically controllable dyes to change the magnitude of the light attenuation; however, nothing in Bylander teaches or suggests that such a system should or could be combined with eyewear that has other electronic systems. Rather, as discussed in the Request for Reconsideration of March 30, 2005 and in the Response to Office Action December 14, 2005, the Office Action relies on improper hindsight reasoning to provide the motivation for combining the references, as will be discussed

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in greater detail below. In addition, there is no indicated expectation of success and even if combined, the combination fails to teach all of the claim limitations.

The Examiner is urged to reconsider the claim rejections in light of the previously-presented arguments. In addition, the Examiner is requested to withdraw the claim rejections in light of the following:

The combination of an interactive electronic device supported by an eyewear frame, and at least one lens configured to have variable light attenuation, as claimed, is a non-obvious combination of eyewear features that provides user benefits which are not contemplated or suggested by either of the cited references. For example, a user can wear eyeglasses indoors, where the eyeglasses include an interactive electronic device, such as an MP3 player. When the user walks outdoors during the day, he or she may desire to continue listening to the MP3 player but also need the benefit of darker lenses to protect his or her eyes from the sun. In such cases, it is advantageous to the user to have eyeglasses that include both an interactive electronic device and a variable light attenuated lens; otherwise, the user would need to replace the eyewear carrying the interactive electronic device with a pair of sunglasses.

Swab clearly fails to contemplate this benefit. For example, as can be seen in his characterization of the prior art in the Background of the Invention section, at column 1, lines 42-53, Swab describes the prior art (emphasis added) as follows:

Additionally, a personal display device built into a frame of eyewear is disclosed at the website of inViso Inc. and may be found at the following URL address: <http://www.inviso.com>. The inViso's eyewear is designed in the shape of sunglasses with the built-in personal display device providing a wearer with a view of his/her computer screen. The displayed view is equivalent to a view provided by a 19-inch desktop monitor from a 2.5 feet distance. In order to display the content of the computer screen on the personal display device, however, the inViso's eyewear has to be plugged into the computer.

Yet nowhere in Swab's specification does he describe either the need to account for changes in ambient light levels or the benefit of doing so, as discussed above. Swab's only reference to sunglasses appears in the Background section, where he distinguishes his invention from sunglass prior art.

In addition, Swab only teaches "communication devices" housed in eyewear frames. For example, at column, lines 49-57, Swab explains (emphasis added), "In addition to housing a

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transceiver, each temple of the provided eyewear may have other communication devices, for example, an audio device, a camera, a speaker, a microphone, a display device such as a liquid crystal or an alarm device, co-molded within its body." Swab does not teach or suggest providing the electronic control system of Bylander's optical lens structure. Therefore, Swab fails to provide any motivation to combine the cited references

Indeed, Bylander's electronic control system includes so many components (see Bylander, FIGs. 6-9) that it is not clear whether Bylander's electronics could be physically combined into the limited volume provided by Swab's eyewear. Therefore, Bylander also fails to provide any motivation to combine the cited references.

Finally, in addition to these reasons and the arguments provided below, the Office Action itself fails to articulate any motivation to combine the cited references. At page 6, the Office Action explains (emphasis added), "obviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." However, the Office Action fails to provide or indicate either a teaching, suggestion, or motivation in the references themselves, or a teaching, suggestion, or motivation in the knowledge generally available to one of ordinary skill in the art.

Instead, the Office Action merely provides, at page 7, "In this case, the purpose of controlling the amount of light that is transmitted through the lens." This reasoning at most explains the purpose of light attenuation, in general, but does not establish a teaching, suggestion, or motivation to combine the references, as required by the law quoted in the Office Action.

For at least these reasons the Examiner is respectfully urged to reconsider and withdraw the claim rejections. In addition, the Applicants traverse the rejections for the reasons previously provided in the previously-provided office action responses.

Claims 14 and 22 are therefore allowable over the cited references. Claims 15-21, which depend from Claim 14, and Claims 23-29, which depend from Claim 22, are therefore allowable for at least the same reasons. In addition, Claims 15-21 and 23-29 are patentable for the unique combination of elements recited therein. Applicants respectfully request withdrawal of the rejection of these claims.

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**The Applied Combination of Swab et al./Young Does Not Make Obvious Claims 14-33**

Claims 14-21 stand rejected under 35 U.S.C. § 103(a) as being obvious over Swab et al. in view of Bylander. For many of the same reasons provided above with respect to the Swab, et al. and Bylander combination, Applicants respectfully traverse the present rejection.

As discussed above, Swab, et al. teach eyewear with a transceiver for forming ad hoc networks. However, as admitted by the Office Action, nothing in Swab, et al. teaches or suggests any devices for changing the light attenuation provided by the lenses thereof.

Young teaches variable density spectacles having a pair of superposed iodine stained light polarizing elements, one of such elements being rotatable through an arc of less than 90 degrees to provide changes in the light transmitting functionality of the superposed elements; however, nothing in Young teaches or suggests that such a system should or could be combined with eyewear that has other electronic systems. Rather, as discussed in the Request for Reconsideration of March 30, 2005, the Response to Office Action of December 14, 2005, and above, the Office Action relies on improper hindsight reasoning to provide the motivation for combining the references. In addition, there is no indicated likelihood of success in combining the cited references.

First, as discussed above, no motivation to combine the cited references is provided. Second, as discussed above, no reasonable indication of success in doing so is provided. Finally, neither a teaching nor a suggestion to make the claimed combination nor a reasonable expectation of success can be found in the cited references, and not based on the Applicant's disclosure.

Claims 14 and 22 are therefore allowable over the cited references. Claims 15-21, 30, and 31, which depend from Claim 14, and Claims 23-29, 32, and 33, which depend from Claim 22, are therefore allowable for at least the same reasons. In addition, Claims 15-21 and 23-33 are patentable for the unique combination of elements recited therein. Applicants respectfully request withdrawal of the rejection of these claims.

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**Request For Telephone Interview**


In view of the forgoing, the Application is in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, Applicants' undersigned attorney of record hereby formally requests a telephone interview with the Examiner. Applicants' attorney can be reached directly at (949) 721-7608 or at the number provided below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By:   
Andrew I. Kimmel  
Registration No. 58,855  
Attorney of Record  
Customer No. 20,995  
(949) 760-0404

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# APPENDIX